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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/813,271

03/31/2004

Osamu Takahashi

119305

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OLIFF & BERRIDGE, PLC  
P.O. BOX 320850  
ALEXANDRIA, VA 22320-4850

EXAMINER

EBRAHIMI DEHKORDY, SAEID

ART UNIT

PAPER NUMBER

2625

MAIL DATE

DELIVERY MODE

02/27/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/813,271

Applicant(s)

TAKAHASHI, OSAMU

Examiner

Saeid Ebrahimi-dehKordy

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 24-28 is/are rejected.
- 7) ☒ Claim(s) 22 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

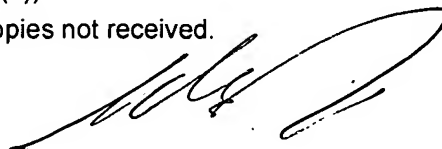
### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.



### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-21 and 24-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Momose et al (U.S. patent 6,301,013)

**Regarding claim 1, 21 and 25-26** Momose et al disclose: A print controller (note Fig.1 item 1 the host computer) for controlling an image print unit to print an index image on a recording medium to be used for separation when a printed record medium is recycled (note column 2, lines 40-50, wherein the type of the paper used is indexed for recognition) comprising: an output unit that outputs image data representing an image to be printed on the record medium to the image print unit (note Fig.1 item 2, the printing device, also Fig.4, column 11, line 62 to column 12, line 10) and an index unit that determines the index image to be printed on the record medium together with the image by the image print unit based on a printing condition (note Figs.10-15, column 17, line 61 to column 18, line 23, wherein the indexing is done for the image based on printing condition).

**Regarding claim 2** Momose et al disclose: The print controller according to claim 1, wherein the printing condition is determined based on at least one of the image data and type of the record medium (note column 18, lines 24-50).

**Regarding claim 3** Momose et al disclose: The print controller as claimed in claim 1, further

comprising: an index print unit that produces image data representing the index image (note column 15, lines 1-15).

**Regarding claim 4** Momose et al disclose: The print controller as claimed in claim 3, wherein the index print unit causes the output unit to output the image data so as to include the image data representing the index image (note Figs. 7 and 14, column 12, lines 10-40 and column 15, lines 15-36).

**Regarding claim 5** Momose et al disclose: The print controller as claimed in claim 1, wherein the index unit includes a print ratio calculation unit that calculates the occupation ratio of the image to the record medium on which the image is printed as a print ratio; and the index unit determines the index image based on the print ratio (note column 12, lines 17-40).

**Regarding claim 6** Momose et al disclose: The print controller as claimed in claim 5, wherein the print ratio calculation unit calculates the print ratio based on the number of pixels of the image to be printed (note column 15, lines 55-67).

**Regarding claim 7** Momose et al disclose: The print controller as claimed in claim 5, wherein the print ratio represents the ratio of the area of the image to the area of both sides of the record medium on which the image is to be printed (note column 3, lines 4-22).

**Regarding claim 8** Momose et al disclose: The print controller as claimed in claim 5, wherein the index unit determines a group name for the separation and determines the index image so as to represent the group name (note column 18, lines 10-24).

**Regarding claim 9** Momose et al disclose: The print controller as claimed in claim 8, wherein the index decision unit determines the group name based on color of the image (note column 18, lines 10-24).

**Regarding claim 10** Momose et al disclose: The print controller as claimed in claim 1, further comprising: a medium judgement unit that judges a type of the record medium; wherein the index unit determines the index image based on the type of record medium (note column 18, lines 10-50).

**Regarding claim 11** Momose et al disclose: The print controller as claimed in claim 10, wherein the medium judgement unit judges the type of the record medium based on an entry operation (note column 11, lines 31-44).

**Regarding claim 12** Momose et al disclose: The print controller as claimed in claim 10, wherein the index decision unit determines a group name for the separation based on the type of the record medium and determines the index image so as to represent the group name (note column 18, lines 10-24).

**Regarding claim 13** Momose et al disclose: The print controller as claimed in claim 1, wherein the index decision unit determines a group name for the separation and determines the index image so as to represent the group name; and the index unit changes a criterion for determining the group name based on entry operation (note column 11, lines 22-44).

**Regarding claim 14** Momose et al disclose: The print controller as claimed in claim 1, wherein the index image includes a bar code representing an index indication description thereof (note column 13, lines 15-32).

**Regarding claim 15** Momose et al disclose: The print controller as claimed in claim 5, wherein the index image includes the print ratio (note column 12, lines 17-40).

**Regarding claim 16** Momose et al disclose: The print controller as claimed in claim 3, wherein the index print unit causes the image print unit to print the index image on the same side of the

record medium as the image (note Fig.7, column 12, lines 17-40).

**Regarding claim 17** Momose et al disclose: The print controller as claimed in claims 1, further comprising an inhibition unit that inhibits an operation of the index print unit based on entry operation (note

**Regarding claim 18** Momose et al disclose: The print controller as claimed in claims 1, wherein the index unit decides the index image based on color of the image (note column 15, lines 1-15 and column 18, lines 10-23).

**Regarding claim 19** Momose et al disclose: The print controller as claimed in claims 1, wherein the index unit decides the index image based on a size of the recording medium (note column 15, lines 1-15).

**Regarding claim 20** Momose et al disclose: The print controller as claimed in claims 1, wherein the index unit decides the index image based on a content of the image (note column 12, lines 10-40).

**Regarding claim 24 and 27-28** Momose et al disclose: A program product for causing a computer to function as: print ratio calculation means for calculating the occupation ratio of an image to be printed on a record medium to the record medium as a print ratio (note column 11, line 61 to column 12, line 40) and index print means for determining an index image used as an index of separation for recycling the record medium based on the print ratio calculated by the print ratio calculation means and performing processing to print the index image on the record medium (note column 3, lines 4-22 and column 15, lines 55-67).

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 24-25** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 24-25 defines a computer program product embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., “When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized” – Guidelines Annex IV). That is, the scope of the presently claimed a computer program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on “computer-readable medium” or equivalent in order to make the claim statutory. Any amendment to the claim should be commensurate with its corresponding disclosure.

*Allowable Subject Matter*

4. Claims 22-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**CONTACT INFORMATION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saeid Ebrahimi-dehKordy whose telephone number is 571-272-7462. The examiner can normally be reached on Mon-Fri, 8:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

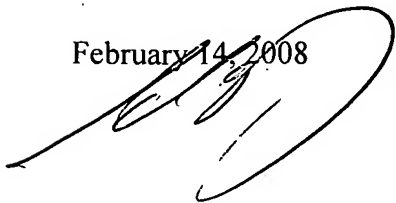
Saeid Ebrahimi  
Patent Examiner  
Group Art Unit 2625



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February 14, 2008

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